

Appl. No. 09/509,637  
Amdt. Dated January 5, 2005  
Reply to Office action of October 22, 2004  
Attorney Docket No. P08581-US1  
EUS/J/P/05-3001

### REMARKS/ARGUMENTS

Regarding the paragraph 5 in the Final Office Action, the application is rejected because the Applicant stated in the previous response at the top of page 10, "There has been new matter added as a result of the amendments."

Prior to the Final Office Action an amendment to the Specification was made because, as the Examiner noted in an earlier non-final Office Action, there was no definition of "intelligent network" and the claims contained the term "units" that was not defined in the specification. The Applicant added a definition of intelligent network in the background of the specification and replaced the "units" term in the claims. In Paper 10 mailed August 10, 2004, the Applicant's Arguments were rejected because "the applicant has stated at the top of page 10 in the amendment that "There has been new matter added as a result of the amendments.""

The Applicant responded to the rejection by emphasizing that the statement at the top of page 10 should have read; "There has been no new matter added as a result of the amendments." The contents of the argument regarding the error are shown below.

Regarding the Response to the Applicant's Arguments of the previous Office Action, the Examiner has rejected the application because the Applicant stated in the previous response at the top of page 10, "There has been new matter added as a result of the amendments." The Applicant respectfully submits that the sentence should have read, "There has been no new matter added as a result of the amendments." There was a typographical error, omission of the word "no" in the sentence, which was overlooked by the Applicant. The Applicant respectfully requests that the Examiner withdraw rejection of the application.

In the Manual of Patent Examining Procedure subject matter that is considered to be new matter must be clearly identified by the examiner. (MPEP, Chapter 608.04). With all due respect, the Examiner did not identify the new matter in the Final Office

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Action (Paper 10) nor was the new matter identified in the Advisory Action (Paper 20041001). Further, the Advisory action reiterated the rejection of Claims 1-20 as not placing the application in condition for allowance for the same reasons as that in the Final Office Action stating: "the prior rejection covers the amendments."

The Applicant is not certain, but the rejection may be due to the addition of the definition of intelligent network to the background of the specification. If this is the case, adding matter to the background does not constitute adding new matter. The Applicant respectfully submits that an honest attempt was made to address the rejection by pointing out the error made in the Applicant's March 26 amendment/response. The Applicant respectfully requests the withdrawal of the rejection of the application for the reasons stated above.

### **Amendments**

The Applicant has amended claims 1-3, 5, 8-9 and 13 to more clearly and distinctly claim the invention to which the Applicant is entitled. NO new matter is added as a result of the amendments. Claims 1-3, 5-11 and 13 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

### **Claim Rejections ~ 35 U.S.C. § 103 (a)**

Claims 1-20 are rejected under 35 U.S.C § 103(a) as being unpatentable over Baker *et al.* (US 5,884,292 A, hereinafter Baker) in view of Hayashida (EP 2 768 628 A2, hereinafter Hayashida). Claims 4, 12 and 14-20 have been canceled rendering the rejection of these claims moot. The Applicant respectfully traverses the rejection of the remaining claims, claims 1-3, 5-11 and 13.

The object of the Baker reference is "for providing items of value, charging the items to a smart card, and for recharging the smart card." (Abstract) The Baker reference appears to disclose a system comprising a station and a Data Center. A subscriber contacts the Data Center and requests a recharge of a smartcard. The Data Center sends an authorization signal that is unique to the subscriber's card to a station

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that could be available to the subscriber. The subscriber connects the smart card to the station and if there is a match, the station updates the funds in the smart card (Abstract, Col. 1, lines 5-10) The subscriber can also use the smart card to pay for services.

The present invention utilizes two subscriber accounts; a prepaid account that is associated with a "user account" in the Intelligent Network (IN). The user account is an account that provides access to services available through the intelligent network. Funds are deposited to the prepaid account by any known manner including voucher means, but what is unique to the Applicant's invention is that funds may be transferred, on demand, in real time and during a call, to the user account from the prepaid account. As the subscriber uses a service, the user account, which starts with an initial balance, determines the amount available in the user account and the probable amount of usage required by the service. If the user account determines that the balance will not cover the use of the service by the subscriber, the user account signals the user to transfer an appropriate credit from the prepaid account to the user account. The credit may be drawn down as needed.

The Baker reference provides an authorization to load value to a smart card at a "station". The present invention utilizes a PIN number in concert with a prepaid voucher number (or equivalent) to load value into a prepaid account operationally connected to the intelligent network and utilizing only the subscriber's mobile phone – no extra apparatus required. In the Applicant's invention, there is no need for a smart card as the prepaid voucher value is linked to an individual number string provided at the time of purchase and the number string is stored in the prepaid account. The funds associated with the string are transferred from the prepaid account to the user account upon entering a PIN number and the individual number string.

The focus of Baker's invention is the smart card and a smart card station that moves funds between a Data Center and the station (Col. 2, lines 25-42). The Applicant's invention moves funds within the same system from a prepaid account to a user account and the user account is debited directly by the subscriber's user interface (mobile communications apparatus) in real time according to the amount of use.

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The Hayashida reference appears to disclose the basic features of a smart card. Hayashida was cited for teaching the fundamentals of the smart card. The Applicant's invention does not incorporate or teach the use of a smart card. As noted above, Baker uses a smart card in the operation of Baker's invention. In contrast to the teaching of the present invention, the references Baker and Hayashida, either alone or in combination, do not disclose or suggest loading funds into a prepaid account that is operationally connected to the IN and associated with a user account from which funds are withdrawn to pay for services. Further, the present invention transfers credit from the amount recorded in the prepaid account to a user account for real time debiting. The amount of debiting occurs according to use of the services available to the user account. The crediting of funds to the user account is accomplished by the user entering a PIN number and an "individual number string" corresponding to the prepaid voucher or similar. Additionally, the present invention allows the user to access the prepaid account to transfer using only the user's interface (i.e., mobile phone).

The combination of Baker and Hayashida shows the storage of funds. However, the stored funds of Baker and Hayashida are applied to the smart card by uploading and downloading information via the smart card and a smart card reader/station. In contrast, the information in the Applicant's invention is stored in the user account and the prepaid account. And information transfer is initiated by the user's interface. Neither Baker nor Hayashida disclose purchasing a voucher or similar. Nor do they teach applying the value of the voucher to a "prepaid" account set up in the intelligent network. Further, in the Applicant's disclosure funds may be transferred from the prepaid account to the user account on demand. The prepaid account and the transfer function are both absent from the prior art. Therefore, Applicants respectfully submit that the combination of Baker and Hayashida does not teach or suggest the invention presently claimed in Claim 1.

Claims 9 and 13 contain similar limitations and the Applicant respectfully submits that Baker and Hayashida individually or in combination, do not teach or suggest the limitations of these amended independent claims. The respective dependent claims contain the same limitations as the amended independent claims and as such are not

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obvious with respect to the presented art of record for at least the reasons recited above. The Applicant respectfully requests the withdrawal of the rejection of claims 1-3, 5-11 and 13.

### CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for Claims 1-3, 5-11 and 13.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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